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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,975	03/19/2004	Daniel Danker	MSI-1897US	7865
22801 7590 10/29/2007 LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			EXAMINER STRONCZER, RYAN S	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/804,975

Applicant(s)

DANKER, DANIEL

Examiner

Ryan Stronczer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 recites the limitation " the program guide includes program schedule information generated by the set top box" in the first step of the claimed method. There is insufficient antecedent basis for this limitation in the claim because it is unclear how the set top box can generate accurate program schedule information without receiving said information from an external source such as a headend or central server. For the purposes of applying prior art in this office action, claim 19 as stated will be considered consistent with claim 18.

Claims 12, 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim language "[o]ne or more" computer readable memories or media fails to distinctly claim the medium or memory which applicant considers part of the invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Since the program schedule information used to populate the program guide is received from a network headend, the "[o]ne or more computer-readable media" recited in claims 22-24 can be interpreted as an electromagnetic signal containing the program schedule information transmitted from the headend to the client device that generates the OSD program guide. This subject matter is not limited to that which falls within a statutory category of invention as defined above because an electromagnetic signal is not a process, machine, manufacture, or composition of matter; instead, it is a form of energy. (See MPEP 2106.01).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-7, 9-13, 15, and 17-29 are rejected under 35 U.S.C. 102(b) as being anticipated by "Digital On-Screen Display: A New Technology for the Consumer Interface" by Vito Brugliera.

Claims 1 and 13 recite methods for displaying a program guide comprising the steps of a client device receiving a request to display a program device and generating a "scrolling program guide." Brugliera describes an "interactive on-screen display (OSD) system" (578) that displays "interactive programming information...where the

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screen displays two half-hour time slots and up to four channels of information at one time, or a 'scrolling' type of format..." (582-3).

Claim 13 further includes the steps of detecting user input and displaying interactive program information. Brugliera also teaches a remote control that is designed for functionality with the OSD system (Fig. 7) that would enable user the user to display program information by pressing the "Info" while a program is selected (584).

Claims 11, 17, and 29 further include the limitation that a "set top box" generates the program guide of claims 1 and 13. Brugliera teaches that the headend provides program guides, among other data, to the subscriber's decoder, which is defined as "[t]he set-top terminal is a self-contained integrated, baseband signal processor" (574-5).

Claim 3 recites claim 1, further comprising the limitation that "the program guide is generated in response to activation of a guide button associated with the client device." The remote control taught by Brugliera includes a "guide" button enabling the user to display the program guide (584).

Claims 4-5 recite "...tuning the client device to a channel associated with the program guide" and "...tuning the client device to a virtual channel." Brugliera discloses the existence of barker channels with scrolling listings displayed in chronological sequence, often with picture-in-picture preview selection for future programming" (577). An example of a barker channel is the TV Guide Channel (previously known as the Prevue Channel), launched in 1988. In addition to being anticipated by Brugliera in

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1993, the functionality of claims 4-5 was available for public use in this country more than fifteen years prior to applicant's filing date.

Claim 6 recites the method of claim 1, further including the limitation of "additional information targeted to a user of the client device." Claim 7 further limits the information of claim 6 to be an advertisement. Brugliera teaches a system that is "specifically designed for PPV [pay-per-view] marketing...any number of channels can have a designated barker message generated by the OSD circuitry. Different groups of decoders can also have different barker messages generated...the overall system is managed by the system controller and associated software" (574-6). In addition, Brugliera discloses a method to provide users with "listings of local advertisements, specials, or video coupons" using the Information menu described on pages 581-2.

Claim 15 is rejected by Brugliera as applied to claim 6.

Claim 9 is rejected by Brugliera as applied to claims 1, 13, and 19.

Claim 10 recites a "configuration file that defines operating parameters for the client device." Brugliera discloses an "OSD transmitter...[that provides] an asynchronous link from the gateway to the set-top terminal's [OSD]...the gateway deciphers the data and transfers it into OSD format" (574). The configuration file recited by claim 10 is inherent in the process taught.

As to claims 12 and 21, the recited "[o]ne or more computer-readable memories containing a computer program that is executable by a processor..." are inherent in the decoder taught by Brugliera. The Brugliera decoder uses two distinct processors to interpret the data received from the headend and display the OSD on the user's

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television. A computer program stored in one or more memories is inherently required for the processors of Brugliera's system to perform the tasks disclosed.

Claim 18 recites the method of claim 13 "wherein a first portion of the program guide is generated by a set top box and a second portion of the program guide is received via a broadcast signal." Brugliera teaches that "[t]wo weeks of programming information can be downloaded to the decoders at a time. The system operator has the option of choosing either a grid format...or a 'scrolling' type of format" (582-3). The decoder(s) is the user's set top box as analyzed re claims 11, 17, and 29, above. The display format selected by the user, either grid or "scrolling," is generated by the decoder and then populated with the program scheduling received from the headend.

Claim 19 is rejected by Brugliera as applied to claim 18 above.

Claim 22 recites "one or more computer readable media having stored thereon a computer program that...causes the one or more processors to: identify program schedule information, identify information regarding a viewer, select promotional content of interest to the viewer..." such a medium and a program are inherently required for the system taught by Brugliera to display program schedule information as well as the advertisements, promotions, and information disclosed on pages 581-583.

Furthermore, Brugliera discloses a remote control that allows the user to cause the user's decoder to display program schedule information, advertisements, or information at the user's discretion. Operation of a remote control also inherently requires a computer-readable medium to communicate with the client device.

Claims 23-4 recite "one or more computer readable media as recited in claim 22" that cause the "one or more processors" to change the operation of the program guide "in response to viewer input." The recited viewer input is consistent with the remote control use as analyzed re claim 22 and claims 23-4 are considered to be rejected by Brugliera as applied to claim 22.

As to claim 25, Brugliera discloses "two weeks of programming information can be downloaded to the decoders at a time. The system operator has the option of choosing either a grid format...or a 'scrolling' type of format" (582-3). The disclosed decoder must have a memory for it to download two weeks of programming information. The processor recited in claim 25 is taught as analyzed re claims 12 and 21.

Claim 26 is rejected by Brugliera as applied to claim 25.

Claim 27 recites claim 25 with the further limitation that the program guide contains "additional information received via a broadcast channel." Brugliera discloses an information menu accessible by pressing the "INFO" on a remote control. When pressed, the button causes the client device to display "extended information such as brief program description, starring actors, or perhaps even a critical rating" (583).

As to claim 28, Brugliera teaches a remote control containing a "guide" button that displays the guide when pressed and an "info" button that displays additional program information when pressed (584). Pressing a button on a remote control is the equivalent of the recited "user input."

Claim 29 is rejected by Brugliera as applied to claim 11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brugliera as applied to claim 1 above, and further in view of EP 0 952 735 (hereinafter EP '735).

Brugliera does not explicitly teach claim 2, which further recites the method of claim 1 further including the functionality of "pausing the scrolling image of the program guide in response to a user input." However, EP '735 teaches "...a system interactively controlled by a TV viewer remote control...[t]he computer is responsive to...a 'stop' control signal from the remote to freeze the scroll output picture signal" [0003]. Therefore, in view of the combined teaching of Brugliera and EP '735 as a whole, it would have been obvious to one skilled in the art to provide functionality of

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“pausing the scrolling image of the program guide in response to a user input” as claimed.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brugliera as applied to claims 6 and 13 above respectively, and further in view of Ellis (International Pub. No. WO 99/60790).

Claim 8, Brugliera teaches claim 6, but does not explicitly teach the further limitation that the information be a “video-on-demand promotion.” At the time of Brugliera’s disclosure, PPV programs were the only form of content that subscribers could purchase from their cable provider and view “on demand.” However, fig. 6B of Ellis discloses an interactive program guide system overlaid on top the broadcast channel, providing the user with a program schedule and a “video clip preview” of the selected program. In the example of Fig. 6B, the video clip preview is of the program being displayed by OSD program guide, which is a video-on-demand (VOD) program. The introduction of VOD distribution services, such as that taught by Ellis, provided users with additional video content that could be purchased through their OSD program guides. Updating the types of advertisements provided by the Brugliera system, as analyzed with respect to claims 6 and 7, to promote the VOD programs taught by Ellis is an application of existing technologies that would have been obvious to one of ordinary skill in the art at the time of the invention.

Claim 16, Brugliera teaches claim 13, but does not explicitly teach the further limitation of video preview functionality as claimed. However, this limitation is taught by

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Fig. 6b of Ellis. Therefore, in view of the combined teaching of Brugliera and Ellis as a whole, it would have been obvious to one skilled in the art to provide functionality of video preview as claimed.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brugliera as applied to claim 13 above and further in view of Knudson et al. (US Patent 6,536,041).

Claim 14, Brugliera teaches claim 13, but does not explicitly teach the further limitation of "changing operation of the program guide to display program information in a scrolling manner after a predetermined time period without user input." However, Knudson et al. teaches an electronic program guide with the following functionality:

If desired, the scrolling action of the controllable ticker may be resumed after a predetermined amount of time elapses (e.g., 15 seconds)...As shown by line 288 [see Fig. 14b], in these situations the program guide resumes scrolling of the controllable ticker and displays the automatically scrolling controllable ticker at step 282 [Fig. 14b]. (Col. 15, Lines 48-53)

The "ticker" referenced by Knudson is a scrolling listing of program schedule information in a manner consistent with that recited in claim 13. The "scrolling ticker" taught by Knudson is the equivalent of the scrolling program guide of claim 13.

Therefore, in view of the combined teaching of Brugliera and Knudson as a whole, it would have been obvious to one skilled in the art to provide functionality of displaying program information in a scrolling manner after a predetermined time period without user input as claimed.

Contact


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Stronczer whose telephone number is (571) 270-3756. The examiner can normally be reached on 7:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan Stronczer/

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